

1 The opinion in support of the decision being entered today is *not* binding precedent
2 of the Board.

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES

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11 *Ex parte* STEVEN C. ROBERTSON

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14 Appeal 2007-1813
15 Application 09/324,601
16 Technology Center 3600

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19 Decided: August 20, 2007

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22 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
23 DAVID B. WALKER, *Administrative Patent Judges*.

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25 FETTING, *Administrative Patent Judge*.

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27 DECISION ON APPEAL

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30 STATEMENT OF CASE

31 Steven C. Robertson (Appellant) seeks review under 35 U.S.C. § 134 of a Non-
32 Final rejection of claims 23-37, the only claims pending in the application on
33 appeal.

34 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6.

35
36 We AFFIRM.

1
2 The Appellant invented an online gift certificate and contribution broker that
3 allows consumers to purchase gift certificates that may be redeemed at any
4 participating electronic merchant (Specification 1:Background – Field of
5 Invention).

6 An understanding of the invention can be derived from a reading of exemplary
7 claim 23, which is reproduced below [bracketed matter and some paragraphing
8 added].

9 23. A system for providing an electronic gift certificate service for
10 users over a distributed network, comprising:

11 [1] a plurality of merchant sites connected to the distributed network,
12 each merchant site running at least one application to provide
13 an online service to users over the distributed network;

14 [2] a plurality of user computers connected to the distributed network,
15 each user computer running at least one application to access
16 the online service at a merchant site;

17 [3] a gift certificate authority site connected to the plurality of
18 merchant sites, the gift certificate site including

19 [a] a user database and

20 [b] a merchant database,

21 each database containing authentication information as to
22 respective users and merchants,

23 [c] and a gift certificate database

24 which stores

25 gift certificate data and

26 transaction data

27 related to particular gift certificates,

1 [d] the users accessing the merchant sites from the user
2 computers over the distributed network; and

3 [e] an authentication protocol for allowing the gift certificate
4 site to authenticate users and merchants;

5 [4] whereby

6 [a] a user purchases a gift certificate having a unique gift
7 certificate identification code on the gift certificate authority
8 site for use at a merchant site, and

9 [b] a merchant site processes the gift certificate through the gift
10 certificate database on the gift certificate authority site.

11 This appeal arises from the Examiner's Non-Final Rejection, mailed May 9,
12 2006. The Appellant filed an Appeal Brief in support of the appeal on August 28,
13 2006, and an Examiner's Answer to the Appeal Brief was mailed on October 5,
14 2006. A Reply Brief was filed on December 11, 2006.

15 PRIOR ART

16 The Examiner relies upon the following prior art:

17 Gillin US 7,010,512 B1 Mar. 7, 2006

18 REJECTION¹

19 Claims 23-37 stand rejected under 35 U.S.C. § 102(e) as anticipated by Gillin.

¹ An August 13, 2004 Final Rejection contained three rejections under 35 U.S.C. § 103. The Brief contends these rejections (Appeal Br. 6-16). The Examiner withdrew these rejections and introduced a single new ground of rejection under 35 U.S.C. § 102(e) (Non-Final Rejection 2-4; Answer 2-3). Thus, the rejections under 35 U.S.C. § 103 are not before us, and the Appellant's contentions are therefore moot.

ISSUES

Thus, the issue pertinent to this appeal is whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 23-37 under 35 U.S.C. § 102(e) as anticipated by Gillin.

The pertinent issue turns on whether Gillin describes a gift certificate site containing merchant, user, and gift certificate databases with authentication information for merchants and users.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Claim Construction

01. A public network is a network whose access is not controlled by or limited to a particular business entity or group of business entities (Specification 9:Last ¶).

02. The word “distributed” in the context of a network implies that processing capabilities and services are spread out among different nodes (Specification 9:Last ¶).

03. The Specification contains no other lexicographic definitions of terms.

1 *Gillin*

2 04. Gillin is directed towards debit/credit/charge accounts, but without
3 issuing physical cards and providing them to the gift recipient, which
4 provides significant advantages to transactions normally involving gift
5 certificates (Gillin, col. 4, ll. 55-59).

6 05. Gillin's "transfer instrument" is used to refer generically to the result
7 of Gillin's inventive transfer methods, which will typically be used in
8 the gift giving context. The transfer instrument is intangible in that it is
9 not physically produced (Gillin, col. 8, ll. 39-43).

10 06. Gillin describes use of its transfer instrument for the purchase of
11 goods or services from any merchant who is capable of processing
12 economic transactions involving one of the plurality national card
13 accounts for which a physical card has issued, but without presentment
14 of the physical card (Gillin, col. 5, ll. 13-19).

15 07. Gillin uses the existing authorization infrastructure of Visa,
16 Mastercard, and American Express (Gillin, col. 7, ll. 30-33).

17 08. Gillin shows communication among the user, merchant and the
18 transfer instrument account (Gillin, Fig. 3).

19 09. In Gillin, the transfer instrument issuer's Issuing Bank enters the
20 instrument recipient's account information into its database (Gillin, col.
21 7, ll. 62-67).

22 10. In Gillin, merchants who wish to accept payments using the cards
23 register with a bank affiliated with the card association. Banks which
24 register merchants are often referred to as acquiring banks or acquirers.

1 Of course, in many instances, the same bank may be both an issuing
2 bank and an acquiring bank. American Express and Discover operate in
3 the roles of both the issuing and acquiring banks (Gillin, col. 9, ll. 5-14).

4 11. In Gillin, authorization typically involves an authorization center
5 which is operated either by or on behalf of the acquiring bank. In general
6 the merchant contacts the authorization center which may in some
7 instances contact the card issuing bank to verify availability of funds or,
8 if the transaction amount is small enough, merely verify that the card has
9 not been blacklisted (Gillin, col. 9, ll. 26-32).

10 12. In Gillin, according to one embodiment, the offerer obtains payment
11 card accounts from an issuing bank. Those accounts, and their
12 associated information, are recorded in the database. The database
13 contains fields for the buyer, the recipient, the denomination, messages
14 to buyers or recipients, a multi-character unique identifier, and a product
15 family table (Gillin, col. 14, l. 47 – col. 15, l. 32).

16 13. In Gillin, payment methods may follow the more prevalent internet
17 related payment schemes, such as CyberCash. CyberCash itself requires
18 merchant registration with CyberCash (Gillin, col. 10, ll. 19-49).

19 14. Gillin allows restrictions on the time frame and the amount of the
20 instrument (Gillin, col. 23, ll. 44-47).

21 15. Gillin describes the purchaser may have been allowed to request
22 notification of when the transfer instrument was used and an identifier
23 for the merchant with whom it was used (Gillin, col. 21, ll. 18-23).

16. Gillis states that an additional feature of the transfer instrument is the ability to make the purchaser anonymous to the recipient (Gillin. col. 20, ll. 24-31).

17. Gillis states that the purchaser provides the recipient's e-mail address, telephone number, and/or mailing address (Gillin, col. 17, ll. 40-43).

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater* , 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580, 146 USPQ 69, 70 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ 2d 1671, 1674 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this must be done with reasonable clarity, deliberateness, and precision; where an inventor chooses to give terms uncommon meanings, the inventor must set out any uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change).

1 *Anticipation*

2 "A claim is anticipated only if each and every element as set forth in the claim
3 is found, either expressly or inherently described, in a single prior art reference."
4 *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d
5 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or
6 compositions, either generically or as alternatives, the claim is deemed anticipated
7 if any of the structures or compositions within the scope of the claim is known in
8 the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed.
9 Cir. 2001). "The identical invention must be shown in as complete detail as is
10 contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236,
11 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as
12 required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of
13 terminology is not required. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566,
14 1567 (Fed. Cir. 1990).

15 ANALYSIS

16 *Claims 23-37 rejected under 35 U.S.C. § 102(e) as anticipated by Gillin.*

17 *Independent Claim 23*

18 The Examiner found that Gillin describes all of the elements of claim 23
19 (Answer 4:¶ beginning "In regards to claim 23").

20 The Appellant presents a long list of contentions regarding claim 23 that we
21 next analyze. But since it is apparent that the most pertinent issue is whether Gillin
22 describes a gift certificate site containing merchant, user, and gift certificate
23 databases with authentication information for merchants and users, we address this
24 first.

1 Gillin relies on the banks who issue credit cards to execute its operations.
2 Gillin expressly states that in many instances, the same bank serves both merchant
3 and user (FF 10). Thus, the databases that contain the records for those merchants
4 and users would be on the same site. Gillin also states that the transfer
5 instruments, which are the equivalent of gift certificates, are represented as
6 accounts on the issuer bank's database (FF 09). Thus, all three databases in claim
7 23 element [3] are on the same site. Since this site contains the gift certificate
8 accounts, it may be characterized as a gift certificate authority site. Further, since
9 the databases identify the merchants and users, such identity information is among
10 the information that would be used for authentication.

11 The Appellant contends that Gillin teaches away from the elements of claim 23
12 (Appeal Br. 16:Last ¶). The Appellant contends that a programmatic infrastructure
13 establishing direct connections to merchants is disclosed and claimed, whereas
14 Gillin requires no relationship with merchants (Appeal Br. 17:First ¶).

15 We find no claim limitation regarding a direct connection to merchants in
16 claim 23. In Gillin, a relationship is required with merchants who wish to accept
17 payment using the cards (FF 10). Thus, we find this argument by the Appellant
18 unpersuasive.

19 The Appellant next contends that Gillin offers nothing more than the sale of a
20 temporary credit card (Appeal Br. 17:First full ¶).

21 We find nothing in claim 23 that precludes the sale of temporary cards. A gift
22 certificate, which Gillin replaces, is by its nature temporary. To the extent the
23 Appellant is arguing that Gillin does not sell gift certificates, Gillin expressly
24 describes its instrument as the equivalent of a gift certificate (FF 04). Therefore,
25 we find the appellant's arguments to be unpersuasive.

1 The Appellant next contends that Gillin teaches away from merchant databases
2 because they would be unnecessary if transactions were handled by credit card
3 suppliers (Appeal Br. 17:Second full ¶).

4 Gillin describes registering merchants who wish to accept payments using the
5 cards with the acquiring bank (FF 10). Such registration records the merchant in
6 the bank's records, which therefore form a database of merchants. Therefore, we
7 find the appellant's arguments to be unpersuasive. To the extent the Appellant is
8 arguing that a credit card supplier does not provide a Gift Certificate Authority
9 Site, which claim 23 recites as the location of the database, claim 23 does not
10 preclude a credit card supplier from providing a Gift Certificate Authority Site.
11 Therefore, we find the appellant's arguments to be unpersuasive.

12 The Appellant next contends that Gillin does not describe merchant
13 authentication (Appeal Br. 17:Second full ¶).

14 We initially find that claim 23 does not recite a step of authenticating, but the
15 presence of an authentication protocol that allows authentication. Gillin expressly
16 states that users are authorized (FF 7). Such an authorization performed by a
17 merchant, by virtue of its use of the network used by the major credit cards (FF
18 06), inherently provides the protocol used by these credit card issuers and
19 authenticates the merchant as one with the authority to perform such an
20 authorization. Further, since Gillin's flow also allows use of payment forms such
21 as those of CyberCash, which requires merchant registration, at least those
22 merchants using CyberCash are authenticated. Therefore, we find the appellant's
23 arguments to be unpersuasive.

1 The Appellant next contends that Gillin does not describe a software module
2 on a merchant site expressly for the purpose of communicating directly with the
3 Gift Certificate Authority Site and server application (Appeal Br. 18:First ¶).

4 We find that claim 23 contains no limitation of a software module on a
5 merchant site expressly for the purpose of communicating directly with the Gift
6 Certificate Authority Site and server application. To the extent the Appellant is
7 arguing that Gillin fails to show communication between the user, merchant, and
8 Gift Certificate Authority Site, Gillin in fact shows communication among those
9 entities (FF 08).

10 The Appellant next contends that Gillin does not suggest the claimed robust
11 range of utility and control (Appeal Br. 18:First ¶).

12 We find no recitation of a robust range of utility and control in claim 23.
13 Therefore, we find the appellant's arguments to be unpersuasive.

14 The Appellant further contends that the claimed gift certificate system doesn't
15 distribute credit card accounts and doesn't use an established credit card issuing
16 banking system (Reply Br. 2:Second full ¶).

17 Claim 23 recites no limitation precluding credit card accounts as the basis for
18 the gift certificates, nor use of an established credit card issuing banking system.
19 Therefore, we find the appellant's arguments to be unpersuasive.

20 The Appellant next contends that Gillin fails to show a gift certificate, just
21 credit cards, and fails to show a distributed network, or a plurality of merchants,
22 who all have sites connected to the distributed network. The Appellant argues that
23 Gillin's requirement that merchants be capable of seeking authorization restricts
24 some merchants from the network (Reply Br. 2:Last ¶).

1 Gillin expressly uses its transfer instrument as the equivalent of a gift
2 certificate (FF 04). Further, Gillin allows any merchant who is capable of
3 processing economic transactions involving one of the plurality national card
4 accounts access. Such access is through a distributed network. To the extent the
5 Appellant is arguing that claim 23 requires that all merchants who are connected to
6 the network have access to the gift certificate, we find no such limitation in claim
7 23. Therefore, we find the appellant's arguments to be unpersuasive.

8 The Appellant next contends that Gillin fails to show a Gift Certificate
9 Authority Site (Reply Br. 3:First full ¶). The Appellant further contends, that if the
10 Examiner equates Gillin's transfer instrument issuer with the Gift Certificate
11 Authority Site, that the transfer instrument issuer has no relationship with
12 merchants (Reply Br. 4:First ¶).

13 Gillin shows show a Gift Certificate Authority Site (Gillin's transfer instrument
14 account site) and a relationship with merchants (FF 08). Therefore, we find the
15 appellant's arguments to be unpersuasive.

16 The Appellant next repeats the above contentions that Gillin does not show
17 merchants interacting directly with a Gift Certificate Authority Site (Reply Br.
18 4:Third ¶), and that Gillin has no merchant database (Reply Br. 5:First ¶). We find
19 these contentions similarly unpersuasive in their repetition.

20 The Appellant next contends that Gillin does not record gift certificate
21 transaction data (Reply Br. 5:First and second full ¶).

22 Gillin shows the use of the credit card infrastructure which records transaction
23 data. Since Gillin's transfer instrument is implemented with such an account, the
24 transaction data for the account would be gift certificate transaction data (FF 07).
25 Therefore, we find the appellant's arguments to be unpersuasive.

Dependent Claims 24-28

The Examiner found that Gillin teaches: (claim 24) placing restrictions on the use of the gift certificate; (claim 25) tracking use of the gift certificate by the user; (claim 26) search mechanism operatively associated with the gift certificate database that provides access to the user to those sales transactions associated with a particular user gift certificate; (claim 27) user anonymity that is effected by preventing merchant site access to any user related data, other than the gift certificate identification code; and (claim 28) within the gift certificate database, and in conjunction with merchant site processing of the gift certificate through the gift certificate database, splitting of the gift certificate across multiple purchases at a plurality of merchant sites (Answer 4:Last ¶-5:Fourth ¶).

The Appellant contends that the restrictions on the use of the gift certificate of claims 24 and 28, the ability to timely track, report and search transactions of claims 25 and 26, the level of anonymity provided the purchaser within Claim 27, all further defined in the specification, are not possible with a system and method that utilizes the existing credit/bank/charge card infrastructure, which is pointedly not configured to perform such functions. In fact, the current credit card system is configured to perform oppositely (Appeal Br. 18:Second ¶).

The Appellant further argues that in Claim 24, the only restrictions that may be placed on the use of the temporary credit cards of Gillin are those commensurate to an ordinary credit card purchase and that this is not the range of restrictions claimed and further described in Applicant's specification. The Appellant argues that the "transfer instrument" of Gillin could never restrict where purchases might

1 be made as Applicant's system and method does, because it can be used wherever a
2 credit card can be used (Appeal Br. 18:Last ¶ - Top of 19).

3 Gillin allows restrictions on the time frame and the amount of the instrument
4 (FF 14). Claim 24 does not recite any particular restriction and claim 28 recites no
5 restrictions. Ability to track, report and search transactions is an option in Gillin
6 (FF 15). Gillin has the ability to make the purchaser anonymous to the recipient
7 (FF 16). Therefore, we find the appellant's arguments to be unpersuasive.

8 *Independent Claim 29 and dependent claim 33*

9 The Examiner found that Gillin describes the elements of independent claim 29
10 (Answer 5:Fifth ¶).

11 The Appellant, arguing claims 29 and 33 together, contends that Gillin assigns
12 the purchaser one of their stockpile of credit card numbers, thereby again teaching
13 away from creating a gift certificate with unique identifier, under the control of the
14 Gift Certificate Authority Site of Applicant's system and method (Appeal Br.
15 19:First full ¶).

16 Gillin's account number is a unique identifier under control of the issuer (FF
17 12). Therefore, we find the appellant's arguments to be unpersuasive.

18 *Dependent claims 30-32*

19 The Examiner found that Gillin teaches (claim 30) ahead of the step of gift
20 certificate site validation, the user associates a fixed shipping address with the gift
21 certificate; (claim 31) ahead of the step of gift certificate site validation, the user
22 associates a restriction on certificate use the restriction selected from the group of
23 restrictions consisting of restriction on certificate use by category of product or
24 service, restriction on certificate use by age range of product or service, restriction

1 on certificate use by dollar limitations on a per order or per item basis, restriction
2 on certificate use by date of use range, and restriction on certificate use to use at
3 selected merchant sites; and (claim 32) the restriction on certificate use is a
4 restriction on certificate use by category of product or service (Appeal Br.
5 19:Second full ¶).

6 The Appellant, arguing claims 30-32 together, contends that Gillin teaches
7 away, because restriction of the use of a credit/debit/charge card cannot be made.
8 Without the claimed control over the gift certificate, the shipping address for
9 purchases made with the gift certificate cannot be predetermined as required by
10 Claim 30 and the restrictions described in Claims 31 and 32 cannot be. The
11 Appellant points to several examples of restrictions in the Specification that are not
12 found in Gillin (Reply Br. 6:Last 2 ¶'s to top of 7).

13 Gillin at least shows restrictions on the date of use range (FF 14), which is
14 among the limitations, only one of which is needed, in claim 31. Gillin also
15 describes getting claim 30's shipping address (FF 17). Therefore, we find the
16 appellant's arguments to be unpersuasive.

17 *Independent Claim 34*

18 The Examiner found that that Gillin describes the elements of independent
19 claim 34 (Answer 6:Third ¶).

20 The Appellant contends that Gillin does not teach an interaction between the
21 merchants and a gift authority site; in fact it teaches away by teaching the
22 necessary step of running all the transactions through "Acquiring Banks" (Appeal
23 Br. 19:Third full ¶).

1 The Appellant argued this in claim 23 and we find it unpersuasive for the same
2 reasons.

3 *Independent Claim 35 and dependent claims 36 and 37*

4 The Examiner found that that Gillin describes the elements of independent
5 claim 35 (Answer 6:Last ¶).

6 The Appellant contends that Gillin fails to present any teaching or suggestion
7 whatever as to contribution management or brokerage, and the Examiner has made
8 no reference at all to these claims as to alleged corresponding elements in Gillen.
9 The Appellant admits that, while a Gillen-style card itself could be donated to a
10 charity, the Appellant contends that its usefulness to the charity would be severely
11 limited to whether the card had a very large value or not; otherwise, the charity
12 would be constrained to use the card limits of dozens or hundreds of cards to effect
13 any significant purchases for its enterprise. In contrast, the claimed system allows
14 for direct deposit to a beneficiaries bank account, so that all contributions effected
15 through the claimed system are aggregate and fungible for any particular charity
16 (Appeal Br. 20:First ¶).

17 As the Examiner found, claim 35 is essentially the same as claim 23 with the
18 word “beneficiary” replacing “merchant” and the word “contribution” replacing the
19 phrase “gift certificate” (Answer 6:Last ¶). The Examiner argues that this
20 distinction is non-functional, which we find as well. Thus, the Appellant is merely
21 claiming providing the gift certificate of claim 23 to a beneficiary. Since both
22 claims are system claims, the structure is identical and therefore the finding that
23 Gillin anticipates claim 23 necessarily means that it also anticipates claim 35.

1 The Appellant has not sustained its burden of showing that the Examiner erred
2 in rejecting claims 23-37 under 35 U.S.C. § 102(e) as anticipated by Gillin.
3 Therefore, we find the appellant's arguments to be unpersuasive.

4 REMARKS

5 The Appellant contends that the Examiner has made no attempt to address
6 arguments presented by Applicant in his original brief regarding the distinction
7 between the appealed claims and a system based upon existing infrastructures for
8 temporary credit cards, even though the previously cited articles, Webcertificate 1
9 and 2 were based upon just such a system and such arguments were presented by
10 Applicant in the original brief (Appeal Br. 20:Second ¶).

11 As we noted above, the Examiner withdrew the rejections under 35 U.S.C.
12 § 103, so they are not before us. Thus, any of Appellant's contentions regarding
13 such withdrawn rejections are therefore moot. Thus, we find no reversible error in
14 the Examiner's failure to address Appellant's contentions regarding the withdrawn
15 rejections.

16 CONCLUSIONS OF LAW

17 The Appellant has not sustained its burden of showing that the Examiner erred
18 in rejecting claims 23-37 under 35 U.S.C. § 103(a) as unpatentable over the prior
19 art.

20 On this record, the Appellant is not entitled to a patent containing claims
21 23-37.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 23-37 under 35 U.S.C. § 102(e) as anticipated by Gillin is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

vsh

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